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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,023	05/24/2001	Michael Aven	AM100307-00	2884

7590

12/18/2001

Intellectual Property Department  
BASF Corporation  
3000 Continental Drive - North  
Mount Olive, NJ 07828-1234

EXAMINER
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CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/18/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/865,023

Applicant(s)

Aven et al

Examiner

S. Mark Clardy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 24, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 20) ☐ Other:

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Claims 1-13 are pending in this application which claims the benefit under 35 USC 119(e) of US Provisional Application No. 60/213,819, filed June 23, 2000, and 60/222,535, filed August 2, 2000.

Applicants' claims are drawn to solid granular herbicidal compositions (claims 8-11) comprising:

- 1) an aryloxy pyrimidine or aryloxy pyridine derivative (formula I)

Claim 4: diflufenican<sup>1</sup>, picolinafen<sup>2</sup>, "TTP"<sup>3</sup> 90 + 2%

- 2) a solid carrier (gypsum, clays, polyvinylpyrrolidone, polyvinylacetate, cyclodextrin (see claim 9), sugar, mixtures/copolymers, and optional solid auxiliaries).

Also claimed are methods of enhancing the herbicidal efficacy of the pyrimidine/pyridine derivatives by formulating them in solid form (claims 1-7) and herbicidal methods of use (claims 12-13). The formulation methods include mixture of the above with a second herbicidal agent (claim 7).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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<sup>1</sup>2',4'-difluoro-2-( $\alpha,\alpha,\alpha$ -trifluoro-m-tolyloxy)-nicotinamide

<sup>2</sup>N-(4-fluorophenyl)-6-[3-trifluoromethylphenoxy]-2-pyridine carboxamide

<sup>3</sup>4-(3-trifluoromethylphenoxy)-2-(4-trifluoromethylphenyl)pyrimidine

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Claims 4, 5, 8, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the difluoro component in the chemical name for diflufenican is misspelled.

The remaining listed claims recite both broad and narrow ranges in the same claim. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, the claims recite the broad recitation "clays", and the claim also recites "such as kaolin or bentonite" which is the narrower statement of the range/limitation.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such

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that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Mayer et al (US 6,030,924), Karp et al (US 5,851,952), Hewett et al (US 4,875,925), and Kleemann et al (US 5,849,758).

Mayer et al teach solid herbicidal formulations comprising various active agents including diflufenican (col 3, line 29) and, preferably, picolinafen (lines 48-53). Conventional fillers may be used in the compositions such as clay mineral materials (col 7, lines 30-39).

Karp et al teach the formulation of thienyloxypyri(mi)dines with conventional solid carriers such as clays (col 9, lines 32-44), and in combination with additional herbicidal agents (col 10-11) such as picolinafen (col 11, line 25).

Hewett et al teach diflufenican in combination with a second herbicide (a dinitroaniline) in conventional solid formulations with clay as a carrier (col 7, lines 29-33).

Kleemann et al teach pyrimidine herbicides such as applicants' TTP (claim 6, col 38, lines 56-57), with conventional solid carriers such as clay (col 9, line 40).

One of ordinary skill in the art would be motivated to combine these references because they disclose the formulation of solid herbicidal compositions.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have made a solid herbicidal composition comprising applicants' herbicidal agents and a solid carrier because it is conventional in the herbicidal art to formulate herbicides with

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such carriers and because the prior art teaches that each of the claimed herbicides could be formulated in this conventional way.

No unobvious or unexpected results are noted; no claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

A handwritten signature in black ink, appearing to read 'S. Mark Clardy', is positioned above the printed name.

**S. Mark Clardy**  
**Primary Examiner**  
**AU 1616**

December 14, 2001